

## **REMARKS**

### **INTRODUCTION**

In accordance with the foregoing, no claims have been amended. Claims 16-18, 24 and 26-31 are pending in the application.

### **CLAIM REJECTIONS – 103**

Claims 16-18, 24 and 26-31 were rejected under 35 USC 103(a) as being unpatentable over applicant's admitted prior art (hereinafter "APA") in view of Stemmler (US 4,768,042) (hereinafter "Stemmler").

Stemmler discusses an adjustable size sensing sheet cassette. In Stemmler, the cassette comprises a box-like configuration with the sheet holding cavity in the center surrounded by walls 34. A sheet stack supply platform 35 is urged upwardly by spring means so that the sheet supply is raised above the height of the forward wall 34 at the front of the cassette. A fixed side edge sheet guide 31 and movable side edge sheet guide 28 each have arms 36 pivotally mounted to the rear thereof about pivot points 37, 38 with corner snubbers 40 on the other end of the arms. These snubbers are arranged to ride on the corners of a stack of sheets inhibiting the forward motion of the corners of the sheets when the sheet is fed in the forward position. Stop member 39 inhibits the vertical range of the snubber arms 36. Stemmler, 6:54-7:3 and Figure 1.

### **Claims 16-18, 24 and 26-32**

Independent claims 16 and 24 recite: "...wherein the first and second finger devices move independently from each other." In contrast to claims 16 and 24, neither the applicant's admitted prior art nor Stemmler discuss first and second finger devices moving independently of each other. In the Office Action, in the response to arguments section on page 6, the Examiner states that Stemmler discloses that it is well known to provide a paper handling device with two corner snubbers (the finger devices 40 and 40) that are arranged such that a first one of the finger devices 40 is provided on one corner of a leading edge of a stack of sheets and the second finger device 40 is provided on a movable guide 28, so as to contact another corner of the leading edge of the stack of sheets. See Figures 1, 3 and 4 of Stemmler. The Examiner

points out that Stemmler explains that the corner snubbers are arranged to ride on the corners of the stack of sheets to inhibit forward motion of the corners of the sheets when the sheet is fed in the forward position. This disclosure in Stemmler is cited as providing the motivation for providing the movable guide 25 of the apparatus shown in the APA Figure 1 with a second corner snubber (i.e. a second finger device) so that a forward motion of both corners of the leading end of the sheet is inhibited when the sheets are fed in the forward position. The Examiner then holds that providing the apparatus shown in the APA Figure 1 with a second corner snubber (second finger device), in a manner as taught by Stemmler, will result in the second finger device being moveable independently from the first finger device 14. In particular, the movable guide 25 of APA Figure 1 which would include the second finger device according to the teachings of Stemmler, could be moved from side to side without moving the first finger device 14 of the apparatus of APA Figure 1.

In contrast to the Examiner's assertions, it is respectfully submitted that it is well established that a proposed combination that creates an inoperable reference teaches away from combination. See, for example, *McGinley v. Franklin Sports Inc.*, 262 F.3d 1339, 60 USPQ2d 1001 (Fed. Cir. 2001). Briefly, when the Examiner proposes a combination that makes a prior art reference inoperable for its intended purpose, the resulting inoperable prior art reference may be considered to teach away from the proposed combination, i.e., not to teach the combination, thereby supporting a showing of nonobviousness.

Independent claims 16 and 24 recite first and second finger devices that move independently from each other. The APA does not discuss a second finger device. In Stemmler, the snubbers 40 (corresponding to the first and second finger devices of claims 16 and 24) are attached to the end of arms 36 on guides 28, 31. The components of Stemmler such as the side edge sheet guide 28, rear edge sheet guide 29, bottom plates 50 and 49, cam slots 51 and 52, and the locating pins 53 and 54 move in conjunction with each other according to the positions of the arm ends 45 and 44, including the snubbers 40 which are additionally checked in the vertical direction by stop members 39 on the snubber arms 36. By incorporating the independent paper setting unit 30 discussed in the APA with the adjustable size sensing cassette of Stemmler, an inoperable reference would be created. As such, it is respectfully submitted that claims 16 and 24 are not obvious over the APA and Stemmler.

Claims 17, 18 and 26-31 are dependent on claims 16 and 24, respectively, and are therefore believed to allowable for the foregoing reasons.

Withdrawal of the foregoing rejection is requested.

## CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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